

REMARKS

In the Office Action, the Examiner allowed claims 1, 3-10, and 13-20, rejected claims 12, 21, and 22, and objected to the drawings. By this paper, Applicants added new claims 23-24 and amended claims 3, 4, 8, 10, 12, 14, 18, 21, and 22 for clarification of certain features and to expedite allowance of the present application. These amendments do not add any new matter. Upon entry of these amendments, claims 1, 3-10, and 12-24 will be pending in the present application. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Objection to the Drawings

In the Office Action, the Examiner objected to the drawings because cross-hatching is not illustrated. Specifically, the Examiner stated that “figure 1 is described as ‘section view’, but lacks cross-hatching.” Office Action, page 2. Although Applicants do not necessarily agree with the Examiner’s objection, Applicants amended the drawings as set forth above and provided on the attached Replacement Sheets. In view of this amendment, Applicants respectfully request the Examiner withdraw the objection to the drawings.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 12 and 22 under 35 U.S.C. § 102(b) as being anticipated by Vallet (U.S. Patent No. 4,791,986). Applicants respectfully submit that amended claims 12 and 22 recite features not disclosed in the cited references.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q.

773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Claim Features of Independent Claim 12 Omitted from Cited Reference

Turning to the claims, amended independent claim 12 recites, *inter alia*, “pulling a tensile force on the string... advancing said seal assembly into said wellhead during or after said pulling of said tensile force; and using a mechanical force applied to said seal assembly for said advancing, wherein the mechanical force is independent of the tensile force.”

The cited reference does not teach or suggest that “the mechanical force is independent of the tensile force,” as recited by independent claim 12 (emphasis added). In sharp contrast, Vallet discloses applying only one force to the system via a hook 42 which pulls up the hanger 18 and the string together. Specifically, “the tubing hanger 18 and tubing string is now pulled upwardly by the sub 44 and hook 42.” Vallet, col. 3, lines 55-57. In view of these deficiencies, among others, the cited reference does not anticipate amended independent claim 12.

Claim Features of Independent Claim 22 Omitted from Cited Reference

Amended independent claim 22 recites, *inter alia*, “moving the seal assembly into a secured position with respect to the wellhead; and applying tension to the tubing string

after the seal assembly is in the secured position with respect to the wellhead, wherein moving is different than applying tension.”

The cited reference does not teach or suggest that “moving is different than applying tension,” as recited by independent claim 22 (emphasis added). In sharp contrast, Vallet discloses a hook 42 which moves the hanger 18 up and applies tension to the string simultaneously. Specifically, Vallet states:

[T]he tubing hanger 18 and tubing string is now pulled upwardly by the sub 44 and hook 42. With the packer 16 latched in place, the tubing is upwardly stretched until the slot 20 in the tubing hanger engages the locating pin 36 and the tubing hanger terminates in the position shown in FIG. 3.

Vallet, col. 3, lines 55-57 (emphasis added). As the act of pulling the hanger 18 up and stretching the tube are performed simultaneously by the same force, these actions clearly cannot be different as recited by independent claim 22. In view of these deficiencies, among others, the cited reference cannot anticipate independent claim 22.

For at least these reasons, among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Vallet in view of Wilkins (U.S. Patent No. 6,142, 233). Applicants respectfully submit that amended claim 21 recites features not disclosed by the cited references taken alone or in hypothetical combination.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce

the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Claim Features Omitted from Cited References

Turning to the claims, amended independent claim 21 recites, *inter alia*, “pulling a tensile force on the string... advancing said seal assembly into said wellhead after said pulling of said tensile force; and using a hydraulic piston to advance said seal assembly, wherein said pulling is different from said advancing.”

The cited references, taken alone or in hypothetical combination, fail to teach or suggest that “said pulling is a different motion from said advancing,” as recited by independent claim 21 (emphasis added). In contrast, the primary reference discloses

pulling on a tube both to move the tube hanger 18 and to stretch the tube (i.e., a single motion). Moreover, the secondary reference fails to obviate the deficiencies of the primary reference. Instead, the secondary reference was cited by the Examiner merely for having a hydraulic cylinder which is actuated to create a seal. See Wilkins, col. 6, line 65, to col. 7, line 2. In view of these deficiencies, among others, the cited references, taken alone or in hypothetical combination, cannot render obvious the current independent claim 21.


For at least these reasons, among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is sincerely invited to contact the undersigned attorney at the telephone number indicated below. Indeed, Applicants are available to discuss any Examiner initiated amendments, if the Examiner believes the present claims are not in condition for allowance.

Respectfully submitted,

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